

Remarks/Arguments

This Response is provided in response to a non-final Office Action mailed January 4, 2005, in which claims 1-9, 13, and 15-29 were rejected under 35 U.S.C. §102(e) as being unpatentable over prior art, and further rejected claims 10, 11, 12, and 14 under 35 U.S.C. §103(a) as being unpatentable over prior art.

Claim Amendments

The amendments to independent claims 1, 16, and 21 have not been made for reasons of patentability, but rather have been amended to more particularly point out and distinctly claim the subject matter regarded by the Applicants as their invention. The amendments to the claims have been made to make explicit that which was implicitly inherent and within the ordinary meaning of terms of art used within the language of claims, and as would be understood by one of ordinary skill in the art.

Rejection of Claims Under 35 U.S.C. §102(e)

The Office Action rejected claims 1-9, 13, and 15-29 under 35 U.S.C. §102(e) as being unpatentable over United States Patent No. 6,763,380 issued to Kim Irvin Mayton et al., July 13, 2004 (Mayton '380).

Anticipation means a lack of novelty, and is a question of fact which is reviewed by the reviewing court using a substantial evidence standard. *Brown v. 3M*, 60 USPQ2d 1375 (Fed. Cir. 2001); *Baxter Int'l, Inc. v. McGaw, Inc.*, 47 USPQ2d 1225 (Fed. Cir. 1998). To anticipate a claim, every limitation of the claim must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 58 USPQ2d 1286 (Fed. Cir. 2001). *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831 (2002). Each such limitation must be found either expressly or inherently in the prior art reference. *Schering Corporation v. Geneva Pharmaceuticals, Inc.*, 02-1540, Decided August 1, 2003 (Fed. Cir. 2003).

Mayton '380 fails to identically show either claim limitation of: "conducting a first performance test of a first path using a performance test of a first type over the first path of the plurality of paths between the first and second devices." or the claim limitation of:

“conducting a second performance test of a second path using the performance test of the first type over the second path of the plurality of paths between the first and second devices” of claims 1 and 16. Mayton '380 further fails to identically show the claim limitation of: “a performance test of each of the first and second transport networks is conducted between the first device and the second device over each of the first and second transport networks simultaneously or within a close time proximity,” of claim 21. Therefore, Mayton '380 fails to provide a basis for an anticipation rejection under 35 U.S.C. § 102(e) of independent claims 1, 16, and 21.

Accordingly, the Applicants request withdrawal of the rejection of claims 1-9, 13, and 15-29 under 35 U.S.C. §102(e), and passage of same to allowance.

Rejection of Claims 10, 11, and 14 Under 35 U.S.C. §103(a)

The Office Action further rejected claims 10, 11, and 14 under 35 U.S.C. §103(a) as being unpatentable over Mayton '380 in view of United States Patent No. 6,360,268 issued to Stephen Silva et al., March 19, 2002 (Silva '268). This rejection is respectfully traversed.

The United States Court of Appeals for the Federal Circuit have provided specific guidance regarding the kind of factual findings needed to determine a reason, suggestion, or motivation to combine references in support of a prima facie showing of unpatentability under 35 U.S.C. §103(a). “The reason, suggestion, or motivation to combine may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, “leading inventors to look to references relating to possible solutions to that problem.” *Pro-Mold & Tool Co. v. Great Lake Plastics, Inc.*, 75 F.3d 1568, 1572, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996) (internal citations omitted); *In re Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1458. While the references need not expressly teach that the disclosure contained therein should be combined with another, see *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the

showing of combinability must be "clear and particular." *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617." *Ruiz v. A.B. Chance Co.*, 57 USPQ2d 1161 (CA FC 2000)

Because claims 10, 11, and 14 depend from allowable independent claim 1, and provide further limitations to independent claim 1, depending claims 10, 11, and 14 each stand as patentable claims. Further, because Mayton '380 fails to teach or suggest either claim limitation of: "conducting a first performance test of a first path using a performance test of a first type over the first path of the plurality of paths between the first and second devices," or the claim limitation of: "conducting a second performance test of a second path using the performance test of the first type over the second path of the plurality of paths between the first and second devices" of claim 1, and Silva '268 fails to cure the deficiencies of Mayton '380, a prima facie showing of an obviousness rejection under 35 U.S.C. §103(a) cannot be sustained. Therefore, Silva '268 alone or in combination with Mayton '380 fails to provide a basis for sustaining a rejection of dependent claims 10, 11, and 14 under 35 U.S.C. §103(a). Additionally, the Examiner has failed to show that the combinability of Mayton '380 and Silva '268 to be "clear and particular."

Mayton '380 is directed to "*methods, systems and computer program products for tracking network device performance are provided which, in various embodiments, may track device performance by acquiring and storing routing information for communication connections over the network on a scheduled basis during normal operations and responsive to exception events*" (Mayton '380 abstract), and Silva '268 is directed to "*a distributed automated testing system is provided which is capable of being distributed over a network, such as the Internet, for testing hardware and software. A plurality of users operating computers interface to the automated testing system via user interfaces, which preferably are graphical user interfaces. Each user interface displays test parameter choices to the user from which the user may select test parameters relating to a test to be performed.*" (Silva '268 abstract)

Accordingly, the Applicants request withdrawal of the rejection of claims 10, 11, and 14 under 35 U.S.C. §103(a), and passage of same to allowance.

Rejection of Claim 12 Under 35 U.S.C. §103(a)

The Office Action further rejected claim 12 under 35 U.S.C. §103(a) as being unpatentable over Mayton '380 in view of United States Patent Publication No. 20030036865 published to ZhangQing Zhuo et al., February 20, 2003 (Zhuo '865). This rejection is respectfully traversed.

Because claim 12 depends from allowable independent claim 1, and provides further limitations to independent claim 1, depending claim 12 stands as a patentable claim. Further, because Mayton '380 fails to teach or suggest either claim limitation of: "conducting a first performance test of a first path using a performance test of a first type over the first path of the plurality of paths between the first and second devices," or the claim limitation of: "conducting a second performance test of a second path using the performance test of the first type over the second path of the plurality of paths between the first and second devices" of claim 1, and Zhuo '865 fails to cure the deficiencies of Mayton '380, the Examiner has failed to provide a prima facie showing of an obviousness rejection under 35 U.S.C. §103(a). Therefore, Zhuo '865 alone or in combination with Mayton '380 fails to provide a basis for sustaining a rejection of dependent claim 12 under 35 U.S.C. §103(a).

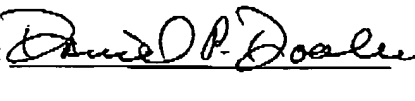
Accordingly, the Applicants request withdrawal of the rejection of dependent claim 12 under 35 U.S.C. §103(a), and passage of same to allowance.

Conclusion

The Applicants respectfully request reconsideration and allowance of all of the claims pending in the application. This Response is intended to be a complete response to the non-final Office Action mailed January 4, 2005.

Should any questions arise concerning this response, the Examiner is invited to contact the below listed Attorneys.

Respectfully submitted,

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